



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re Application of :
Elaine L. Jacobson et al :
Serial No.: 09/834,228 : PETITION DECISION
Filed: April 12, 2001 :
Attorney Docket No.: NIAD 214.1 :

This letter is in response to the petition under 37 CFR 1.181, filed November 26, 2002, requesting withdrawal of the finality of the last Office action.

BACKGROUND.

A review of the file history shows that the examiner mailed a first Office action to applicants on January 2, 2002, setting a three month shortened statutory period for reply. The Office action rejected claims 1-7 and 9-16 under 35 U.S.C. 112, first and/or second paragraphs, as lacking enablement and being indefinite. Claims 1, 3-5 and 11-16 were rejected under 35 U.S.C. 103(a) as unpatentable over Rine in view of Le et al and Otsuka et al. Claims 1-16 were also rejected under 35 U.S.C. 103(a) as unpatentable over Abe et in view of Otsuka et al. Applicants replied on April 1, 2002, by canceling claims 1-16 and adding claims 17-29, and addressing all of the rejections.

The examiner mailed a second Office action to applicants on June 18, 2002, rejecting claims 17, 19-22, 24-25 and 27 under 35 U.S.C. 102(b) as anticipated by Huber. Claims 17-29 were rejected under 35 U.S.C. 103(a) as unpatentable over Huber in view of Le et al and Otsuka et al. Applicants replied on August 29, 2002, by canceling claims 17-29 and adding claims 30-37 and by addressing all of the rejections of record.

The examiner mailed a Final Office action to applicants on November 20, 2002, rejecting claims 30-33 under 35 U.S.C. 102(b), as anticipated by Huber. Claims 30 and 34-37 were rejected under 35 U.S.C. 103(a) as unpatentable over Huber in view of Otsuka et al. An amendment after Final Office action was submitted on February 20, 2003, but has not yet been considered by the examiner. This petition was filed November 26, 2002.

DISCUSSION

Applicants contend that the last Office action should not have been made Final since a claim previously rejected under 35 U.S.C. 103(a) was now rejected under 35 U.S.C. 102(b). Applicants state that present claim 30, rejected under 35 U.S.C. 102(b), corresponds to canceled claim 23 which was rejected only under 35 U.S.C. 103(a).

A careful review of the claims shows that present claim 30 is directed to a method of enhancing oxygen delivery to tissues by applying a composition containing a nicotinic alkyl ester having 8-10 C in the ester portion to the tissue. Claim 23 which depends from claim 21 which depends from claim 19 which depends from claim 17 was rejected in the previous Office action under 35 U.S.C. 103. Claim 23 as it eventually depends from claim 17 is directed to a method of enhancing oxygen delivery by applying a 8-10 C alkyl ester of a first compound which is converted to a vasodilator in a method of enhancing oxygen delivery to tissues. The compound is not specifically identified. Claim 24 which also ultimately depends from claim 17 and was rejected under 35 U.S.C. 102(b), specifies the first compound as a niacin alcohol ester (a nicotinic alkyl ester). The argument by the examiner under 35 U.S.C. 102(b) specifically mentions hexyl nicotinate (C6), citing *inter alia* claim 1 of the reference. The argument under 35 U.S.C. 103(a) specifically identifies butyl-, pentyl-, hexyl-, heptyl- and octyl- nicotinate and cites claim 1 of the reference.

Applicants state that if an examiner could have made a rejection in a previous Office action and raised it in a subsequent Office action the action cannot be made Final. Here, however, the basis for rejection of new claim 30 was set forth in a previous Office action and applied to claims 17, 19-22, 24-25 and 27. Thus the rejection is not a new rejection not previously set forth. Only which claims should have been rejected thereunder may have been in error. However, applicants were specifically put on notice of the teachings of Huber in the rejection under 35 U.S.C. 103(a) which specifically mentions the octyl ester which is now claimed. The now claimed method of applying a nicotinic acid alkyl ester absent any specific alkyl length (e.g. 8-10C) was specifically rejected under 35 U.S.C. 102(b) in the previous Office action when claim 24 was rejected.

DECISION

The petition is **DENIED** for the reasons set forth above. Finality of the last Office action is deemed to be proper.

The application will be forwarded to the examiner for consideration of the amendment filed February 20, 2003.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll 
Director, Technology Center 1600